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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/332,317	06/14/1999	JAMES D. BENNETT	P93-00-DD	2769

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EXAMINER	
ELISCA, PIERRE E	
ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/332,317	James D. Bennett
Examiner	**Art Unit**
Pierre E. Elisca	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *THREE* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07/21/2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-27* is/are pending in the application.

4a) Of the above, claim(s) *1-5* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some* c)☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

RESPONSE TO AMENDMENT

1. This Office action is in response to Applicant's amendment, filed on 07/21/2003.

2. Claims 6-27 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 6-27 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Buchanan et al. (U.S. Pat. No. 5,148,366) in view of Griggs (U.S. Pat. NO. 4,435,617).

As per claims 6, 11, 13, 16, 17, 18, 19, 20, 22, 23, 24, 25 and 26-27 Buchanan substantially discloses a document generation system that is provided for enhancing or replacing the dictation and transcription process. A computer-based documentation system utilizing a document structure manipulated by a user interface... see., abstract, col 2, lines 30-48 (which is readable as Applicant's claimed invention wherein it is stated that a transcription system used to convert [convert or replace or the boiler-plates for managing patient reporting from voice to text] words spoken during a transcription proceeding to a textual form for real time), the transcription system comprising: a

transcriber that produces, in real time, transcript text representative of spoken words (this limitation is disclosed by Buchanan in the abstract, lines 7-16, col 6, lines 10-47, and also col 1, lines 35-68, col 2, lines 1 and 2, **specifically wherein it is stated that a plurality of different reports (hospital's words spoken can be generated for different needs. For, example, a physician will probably create a separate report for initial visits and for follow visits by a particular patient as well as separate report for writing (textual form) a prescription);**

data storage that stores data representative of at least one document relating to the transcription proceeding (this limitation is disclosed by Buchanan in col 4, lines 3-68, specifically relational database);

a user input device supporting the selection of the at least one document (this limitation is disclosed by Buchanan in col 4, lines 18-39, specifically the keyboard 18).

It is noted that **Buchanan** does not explicitly disclose a screen that displays the transcript text as it is produced. However, **Griggs** discloses a speech-controlled phonetic device that utilizes a two-tier approach for converting an audio input into visual form and the speech-controlled also includes a printer display for displaying transcript data (see., fig 1, element 36, col 3, lines 58-68, col 4, lines 1-14). Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the process of dictating and transcribing of **Buchanan** by implementing a screen display as taught by **Griggs** because such modification would provide the process of dictating and transcribing of **Buchanan** with the enhanced necessary to produce, in real

time, a simultaneous printed or displayed output which is, to the greatest extent possible (see., Griggs, col 2, lines 65-68, col 3, line 1).

As per claims 7, 12, 14, 15, 21, Buchanan discloses the claimed limitation, wherein a processor that responds to the user input device as the transcriber produces the transcript text by associating at least a portion of the transcript text with the at least one document (this limitation is disclosed by Buchanan in col 3, lines 26-33, fig 1, element 6).

As per claim 8, Buchanan discloses the claimed limitation, wherein the transcript text is stored in data storage (this limitation is disclosed by Buchanan in col 3, lines 26-33, fig 1, element 2).

As per claims 9, 10, Buchanan discloses the claimed limitation, wherein the user input device supports selection of the portion of the transcript text stored in data storage and wherein the screen displays the portion of the transcript text (this limitation is disclosed by Buchanan in col 4, lines 18-39).

REMARKS

5. In response to claims 6-27, Applicant argues that the prior art of record taken alone or in combination do not teach or suggest:

a. "data storage that stores data representative of at least one document". As specified by the Examiner in the Office action mailed on 03/08/2002, this limitation is disclosed by Buchanan in col 4, lines 3-68, specifically relational database or data storage, Applicant duly note that the relational database 2 also includes information concerning selections of different option text segments within a particular document structure.

b. "A screen that displays the transcript text as it is produced and the image of the at least one document for viewing". However, the Examiner respectfully disagrees as this limitation is disclosed by Griggs, specifically wherein it is stated that a speech-controlled phonetic device that utilizes a two-tier approach for converting an audio input into visual form and the speech-controlled also includes a printer display for displaying transcript data [transcript data or transcript text] (see., fig 1, element 36, col 3, lines 58-68, col 4, lines 1-14). Therefore, Applicant's argument is moot.

c. Applicant also maintains that Buchanan and Griggs cannot combined, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071,5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or

legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App & Inter); and Es parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

d. " data storage that stores data representative of at least one document relating to the transcription proceeding". As stated above, this limitation is disclosed in col 4, lines 3-68, specifically relational database 2.

CONCLUSION

6. The prior art made of record and relied upon is considered to applicant's disclosure.

7. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents of Trademarks

Washington, D.C. 20231

The Official Fax Number For TC-3600

(703) 305-7687

Pierre Eddy Elisca

Patent Examiner

September 29, 2003